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No. 04-1350

In the Supreme Court of the United States

KSR INTERNATIONAL CO., PETITIONER

v.

TELEFLEX INC., ET AL.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE

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QUESTION PRESENTED

Whether a claimed invention can be "obvious," and therefore unpatentable under 35 U.S.C. 103(a), without proof of some "teaching, suggestion, or motivation" to modify or combine the prior art in the manner claimed.

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BRIEF FOR THE UNITED STATES AS AMICUS CURIAE

This brief is submitted in response to the order of this Court inviting the Solicitor General to express the views of the United States. In the view of the United States, the petition for a writ of certiorari should be granted.

STATEMENT

Petitioner KSR International Co. is a Canadian company that markets foot-operated throttle controls—gas pedals—for passenger cars and light trucks. Pet. App. 20a. Respondents Teleflex Inc. and its subsidiary Technology Holding Co. sued KSR in the United States District Court for the Eastern District of Michigan for patent infringement, alleging that two of KSR's adjustable gas pedal systems literally infringe Claim 4 of their U.S. Patent No. 6,237,565 (the Engelgau patent). *Id.* at 1a-2a, 20a, 23a-24a. The district court granted KSR's motion for summary judgment, concluding that Claim 4 of the

Engelgau patent is obvious within the meaning of Section 103(a) of the Patent Act of 1952, 35 U.S.C. 103(a), and therefore invalid. See Pet. App. 18a-49a. The Federal Circuit vacated the grant of summary judgment, concluding that the district court incorrectly applied its "teaching-suggestion-motivation" test in determining that Claim 4 would have been obvious to a person of ordinary skill in the art. *Id.* at 1a-17a.

A. The Patent Act's Requirement Of Nonobviousness

The Patent Clause of the Constitution vests Congress with authority "[t]o promote the Progress of Science and useful Arts by securing for limited Times to * * * Inventors the exclusive Right to their * * * Discoveries." U.S. Const. Art. 1, § 8, Cl. 8. Congress has implemented the Patent Clause through statutory enactments, commonly known as the Patent Acts, that have set out the conditions for securing a patent and that strike "a careful balance between the need to promote innovation and the recognition that imitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy." *Bonito Boats, Inc.* v. *Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989).[1]

The Patent Act of 1952, as amended, provides the current law governing the issuance and validity of patents. See 35 U.S.C. 100 *et seq.* Sections 101 through 103 provide (35 U.S.C. 101-103), as a general matter, that "patentability is dependent upon three explicit conditions: novelty and utility as articulated in § 101 and § 102, and non-obviousness * * * , as set

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[1] See, *e.g.*, Act of Apr. 10, 1790, ch. 7, 1 Stat. 109; Act of Feb. 21, 1793, ch. 11, 1 Stat. 318; Act of July 4, 1836, ch. 357, 5 Stat. 117; Act of Mar. 3, 1839, ch. 88, 5 Stat. 353; Act of July 8, 1870, ch. 230, 16 Stat. 198; Act of Aug. 5, 1939, ch. 451, 53 Stat. 1212; Act of July 19, 1952, ch. 950, 66 Stat. 792.

out in § 103." *Graham* v. *John Deere Co.*, 383 U.S. 1, 12 (1966); see *Bonito Boats*, 489 U.S. at 146-151, 156-157. Because "each of [these conditions] must be satisfied," only those new and useful inventions that would not have been "obvious" at the time of their discovery exhibit the "level of innovation necessary to sustain patentability." *Graham*, 383 U.S. at 4, 17.

Congress enacted Section 103(a) to codify the principle, which this Court first recognized in *Hotchkiss* v. *Greenwood*, 52 U.S. (11 How.) 248 (1851), that a new and useful device does not qualify for a patent unless it embodies a "degree of skill and ingenuity" beyond that of "an ordinary mechanic acquainted with the business." *Id.* at 267. See *Graham*, 383 U.S. at 11-18. Section 103(a) states that a claimed invention is not eligible for a patent

> if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.

35 U.S.C. 103(a). "The nonobviousness requirement extends the field of unpatentable material beyond that which is known to the public under § 102, to include that which could readily be deduced from publicly available material by a person of ordinary skill in the pertinent field of endeavor." *Bonito Boats*, 489 U.S. at 150 (citing *Graham*, 383 U.S. at 15).

The question of nonobviousness is ultimately one of law, but it turns on "several basic factual inquiries." *Graham*, 383 U.S. at 17. This Court has identified four such inquiries: (1) "the scope and content of the prior art"; (2) "differences between the prior art and the claims at issue"; (3) "the level of ordinary skill in the pertinent art"; and (4) "secondary consid-

erations," such as "commercial success," that might provide "indicia of obviousness or nonobviousness." *Id.* at 17-18.

B. The Subject Matter At Issue

The technology at issue in this case is relatively simple and its evolution is straightforward. Before the 1970s, the driver of an automobile typically controlled the vehicle's speed by pressing a foot-operated gas pedal, which was bolted at a fixed location within the footwell of the vehicle interior. The pedal would act as a lever, rotate around a pivot point, and pull a cable or mechanical linkage to actuate the engine throttle. See Pet. App. 20a-21a. In the 1970s, automobile manufacturers began offering adjustable pedal assemblies, designed to accommodate drivers of different heights, that enabled a driver to adjust the pedal position forward and backward within the footwell. *Id.* at 19a-20a; see C.A. App. 1568 (U.S. Patent No. 5,010,782, Col. 1, ll. 14-27 (Asano patent)).[2]

In the 1990s, automobile manufacturers sold increasing numbers of vehicles in the United States that employed

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[2] The driver's adjustment of the pedal position could alter the mechanical "lever[age]" at the pedal pad, by changing the distance between the pad and the pedal pivot, and it could consequently require the driver to apply a different amount of force when operating the pedal. See C.A. App. 1568 (Asano patent, Col. 1, ll. 28-45). The 1989 Asano design addressed that problem by attaching the adjustable pedal assembly to a fixed pivot point located on a stationary bracket in the footwell. See *id.* at 1562, 1565-1567 (Asano patent, Fig. 5-8); Pet. App. 32a-33a. That design then utilized mechanical linkages to preserve a constant force ratio and counteract the effect of adjusting the distance between the pedal pad and pedal pivot. See C.A. App. 1568, 1570-1571 (Asano patent, Col. 1, ll. 48-65; Col. 2, ll. 15-23; Col. 8, l. 63 - Col. 9, l. 4); Pet. App. 12a-13a & n.3. Not all adjustable pedal assemblies seek to address that constant force problem. See, *e.g.*, C.A. App. 1490-1491 (U.S. Patent No. 5,632,183, Col. 1, ll. 35-38, 52-54, Col. 2, ll. 13-15, Col. 4, ll. 26-29 (Rixon '183 patent)).

computer-controlled engines and electronic throttle controls. See Pet. App. 21a, 41a. The manufacturers of gas pedal assemblies adapted their non-adjustable assemblies by attaching an electronic sensor to the pedal, in place of the mechanical linkage, to determine the pedal position and transmit a corresponding electronic signal to the throttle. See *id.* at 21a. The designs of that era reveal configurations for non-adjustable pedals, mounted on the wall of the footwell, in which the electronic pedal position sensor is actuated by the pedal pivot and is located on a stationary wall bracket to which the pedal and its pivot connect. See *id.* at 33a-35a.[3]

Respondents' Engelgau patent reveals an adjustable pedal apparatus that combines an adjustable gas pedal assembly with an electronic pedal position sensor. The electronic sensor, which measures the pedal position at the pivot, is attached to the support bracket that connects the pedal assembly to the wall of the footwell. Pet. App. 2a, 26a. The patent explains that the pedal assembly "can be any of various adjustable pedal assemblies" and the electronic pedal position sensor can be any such sensor "known in the art." C.A. App. 38-39 (Engelgau patent, Col. 2, ll. 54-56; Col. 3, ll. 22-24).

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[3] U.S. Patent No. 5,385,068 (White patent) (C.A. App. 717-723) is illustrative. The White patent, which was filed in 1992, discloses a modular electronic pedal position sensor similar to a sensor later installed in certain 1994 Chevrolet pick-up trucks. That sensor, known as a CTS 503 Series position sensor, was designed to be mounted on the pedal pivot of a gas pedal and included a fitting that allowed the sensor to engage the pedal pivot shaft on different makes and models of vehicle gas pedal assemblies. See Pet. App. 32a, C.A. App. 1051-1053 (Willemsen Decl. paras. 12-19). The sensor was mounted on the pedal support bracket in Chevrolet trucks and determined the pedal's position from the movement of the pedal pivot shaft. *Id.* at 1052-1053, 1077 (Willemsen Decl. paras. 16-17, 19 & Exh. 8). See also, *e.g.*, U.S. Patent Nos. 4,958,607 (Lundberg patent), 5,233,882 (Byram patent), 5,241,936 (Byler patent) (C.A. App. 708-716), 5,887,488 (Riggle patent).

Claim 4, which is set out verbatim at Pet. App. 3a, describes an apparatus composed of: (1) a support mounted to the vehicle structure; (2) an adjustable pedal assembly with a pedal arm that moves fore and aft with respect to the support; (3) a pivot located on the support to which the pedal assembly is attached; and (4) an electronic pedal position sensor attached to the support. *Id.* at 3a, 25a-26a. Claim 4 further describes that the electronic pedal position sensor is responsive to the pivot, the position of which remains constant with pedal arm adjustments. *Id.* at 3a, 26a.

C. The Proceedings Below

KSR supplies a major automobile manufacturer with adjustable gas pedal assemblies for use with electronically controlled throttles in certain truck lines. Respondents, who compete with KSR, brought this suit alleging that KSR's pedal assemblies infringed three of respondents' patents. As a result of a series of motions and stipulations, the parties focused their dispute on whether KSR's pedal assemblies infringed Claim 4 of the Engelgau patent. The parties filed cross-motions for summary judgment, and the district court granted judgment for KSR on the ground that respondents' claimed invention would have been obvious to a person of ordinary skill in the art and that the Engelgau patent was therefore invalid. See Pet. App. 18a-24a.

The district court reached that conclusion based on the four-part inquiry that this Court set out in *Graham*, *supra*. See 383 U.S. at 17-18. It first determined that all of the elements of Claim 4 were revealed in the prior art because the Asano patent taught each element except Claim 4's reference to the use of an electronic pedal position sensor, which other prior art references taught. See Pet. App. 28a-35a. The district court then determined that a person of ordinary skill in the art would have had college training in mechanical engi-

neering and experience in the field of pedal assemblies. *Id.* at 35a-36a. The court next found that there was "little difference between the teachings of the prior art and claims of the patent-in-suit," and it further found that a person skilled in the art would readily "combine a pivotally mounted adjustable pedal assembly [the Asano patent] with an off-the-shelf modular pedal position sensor to solve the problem" that the Engelgau patent addressed. *Id.* at 39a, 44a. The court also evaluated, as a "secondary consideration," respondents' claim of commercial success, but the court concluded that the consideration was "insufficient to overcome [KSR's] clear and convincing evidence of obviousness." *Id.* at 48a.

In analyzing whether it would have been obvious to a person of ordinary skill to combine the Asano patent with an electronic pedal position sensor, the district court applied the Federal Circuit's "teaching-suggestion-motivation test." See Pet. App. 8a, 40a-46a. Under that test, a claimed invention that combined elements already present in the prior art would not have been obvious at the time of invention unless there was a teaching, suggestion, or motivation in the prior art that would have led a person of ordinary skill to combine the prior art references in the manner claimed. See *id.* at 40a-41a. The district court found that a person of ordinary skill would have been motivated to combine pre-existing adjustable pedal assemblies with co-existing electronic pedal position sensors and to avoid known problems with other pedal assemblies. *Id.* at 42a-43a. The court observed that the prior art references were closely related, others in the field had made similar combinations, and the patent examiner, who did not have the benefit of the Asano reference, had recognized similar combinations as obvious. *Id.* at 43a-46a.

The court of appeals reversed on the ground that the district court had incorrectly applied the teaching suggestion-motivation test. Pet. App. 1a-17a. The court of appeals stated

that its test required the district court to make factual findings showing the "specific understanding or principle within the knowledge of the skilled artisan that would have motivated one with no knowledge of [the] invention to make the combination" in "the particular manner claimed by claim 4 of the [Engelgau] patent." *Id.* at 11a-12a (quoting *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000)); see *id.* at 16a. In other words, the court of appeals ruled that the district court could not find the Engelgau patent invalid as obvious without "specific findings as to a suggestion or motivation to attach an electronic control to the support bracket of the Asano assembly." *Id.* at 12a.

The court of appeals concluded that the Asano patent failed to provide such motivation because it addressed "the constant pedal force problem" in adjustable pedal assemblies, see note 2, *supra*, whereas the Engelgau patent purported to disclose a "smaller, less complex, and less expensive electronic pedal assembly." Pet. App. 12a-13a. The court of appeals also stated that the prior art references that taught the importance of avoiding movement of the pedal position sensor's wiring in non-adjustable pedal assemblies likewise were insufficient because they did not address the problem of wire chafing in "an adjustable pedal assembly" and did "not necessarily go to the issue of motivation to attach the electronic control on the support bracket." *Id.* at 13a.

The court of appeals concluded that KSR's other evidence describing the prior use of electronic pedal position sensors failed "to make out a *prima facie* case of obviousness." Pet. App. 14a. The court acknowledged that the evidence demonstrated a motivation to combine an electronic pedal position sensor with an adjustable pedal assembly and showed that such a sensor "'could have been' mounted on the support bracket of a pedal assembly," but the court concluded that it failed to show a particular "motivation to attach the electronic

control to the support bracket." *Id.* at 14a-15a. The court of appeals accordingly concluded that genuine issues of material fact existed concerning "whether a person of ordinary skill in the art would have been motivated * * * to attach an electronic control to the support structure of the [Asano] pedal assembly." *Id.* at 16a-17a. It therefore vacated the district court's judgment and remanded the case "for further proceedings on the issue of obviousness, and, if necessary, proceedings on the issues of infringement and damages." *Id.* at 17a.

DISCUSSION

This Court's decision in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966), sets out a flexible framework for determining whether a claimed invention is nonobvious within the meaning of Section 103(a) of the Patent Act of 1952, 35 U.S.C. 103(a). That decision instructs the lower courts to determine the content of the prior art, identify the differences between the prior art and the inventor's claims, and then determine whether a person of ordinary skill in the field would have found the claimed invention obvious. The Federal Circuit has transformed one means of establishing obviousness under that framework—proof that the prior art provided a teaching, suggestion, or motivation for combining separate prior art references—into an inflexible requirement for determining obviousness. As this case demonstrates, the Federal Circuit's teaching-suggestion-motivation test extends patent protection to non-innovative combinations of familiar elements. The issue is important, because many patent applications rest on the combination of prior art references, and because extension of patent rights to obvious combinations of familiar elements retards, rather than advances, new discoveries. This case presents a sound vehicle for the Court to determine whether the Federal Circuit's teaching-suggestion-motivation

test should continue to serve as the exclusive means of establishing obviousness under Section 103(a).

A. The Federal Circuit's Imposition Of A Teaching-Suggestion-Motivation Test To Determine Whether A Claimed Invention Would Be Obvious Presents An Important Question Of Patent Law That Warrants This Court's Review

1. This Court has explained that "the patent system represents a carefully crafted bargain that encourages both the creation and public disclosure of new and useful advances in technology, in return for an exclusive monopoly for a limited period of time." *Pfaff* v. *Wells Elecs., Inc.*, 525 U.S. 55, 63 (1998) (citing *Bonito Boats, Inc.* v. *Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-151 (1989)). That bargain's effectiveness in inducing creative effort and disclosure depends on "a backdrop of free competition in the exploitation of unpatented designs and innovations," and the nonobviousness requirement is essential in ensuring that "free exploitation of ideas will be the rule, to which the protection of a federal patent is the exception." *Bonito Boats*, 489 U.S. at 151. Section 103(a) embodies the understanding that "concepts within the public grasp, or those so obvious that they readily could be, are the tools of creation available for all." *Id.* at 156; see *Graham*, 383 U.S. at 6.

This Court observed in *Graham* that Section 103(a)'s nonobviousness requirement codifies a "functional approach," traceable to *Hotchkiss* v. *Greenwood*, 52 U.S. (11 How.) 248 (1851), for defining the "general level of innovation necessary to sustain patentability." See *Graham*, 383 U.S. at 3-4, 11-12. That approach proceeds from the perspective of a "hypothetical person" of ordinary skill in the relevant art, *Dann* v. *Johnston*, 425 U.S. 219, 229 (1976), and turns on whether the claimed invention "as a whole" would have been obvious at the

time in light of the "differences between the subject matter sought to be patented and the prior art." 35 U.S.C. 103(a).

The "ultimate question" of patent validity is a question of law, *Graham*, 383 U.S. at 17, but it rests on a judgment, informed by relevant facts, of whether the hypothetical person of ordinary skill in the art would have found the invention as a whole "obvious." Section 103(a) itself identifies three "central factors relevant to any inquiry into obviousness" (*Johnston*, 425 U.S. at 226): the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent art. See *Graham*, 383 U.S. at 17. Other "secondary considerations" —including a long-felt and unfulfilled need for the invention, the prior failures of others, and the commercial success of the invention—may also provide "indicia" supporting the legal conclusion of "obviousness or nonobviousness." *Id.* at 17-18, 35-36.

In specifying nonobviousness as a condition of patentability, Section 103(a) codifies the Court's historic approach to evaluating whether a claimed invention is sufficiently innovative to warrant a patent, *Graham*, 383 U.S. at 17, but it does not specify how courts should weigh the relevant factors in making the legal determination, in any particular case, of whether an invention as a whole would have been "obvious." While the Court identified in its *Graham* decision the framework for analysis and the relevant considerations, it observed that the application of Section 103(a) would continue to depend on the "given factual context," that the inquiry is comparable to that involving similar fact-dependant legal judgments such as "negligence and scienter," and that further refinements "should be amenable to a case-by-case development." *Id.* at 18.

This Court's decisions from *Graham* forward reflect the understanding that courts must apply Section 103(a) "realisti-

cally" as a "practical test of patentability." See 383 U.S. at 17. The Court has accordingly declined to embrace rigid categorical rules that would inflexibly limit the ability of the courts or the United States Patent and Trademark Office (PTO) —which has "the primary responsibility for sifting out unpatentable material" (*id.* at 18)—to make individualized determinations of obviousness. In none of its decisions has the Court adopted the inflexible rule, which the Federal Circuit applied in this case and has consistently articulated in other decisions, that a court or PTO cannot conclude that a claimed invention would have been obvious unless it makes "specific findings showing a teaching, suggestion, or motivation to combine prior art in the particular manner claimed by the patent at issue" (Pet. App. 16a).[4]

2. The Federal Circuit's teaching-suggestion-motivation test subjects persons challenging the validity of a patent, as well as PTO's patent examiners, to substantial obstacles in establishing obviousness beyond those that Section 103(a) and this Court's decisions prescribe. As this case aptly demonstrates, the Federal Circuit's rigorous and inflexible application of its test alters *Graham*'s functional approach to the nonobviousness inquiry in a way that unnecessarily sustains patents that would otherwise be subject to invalidation as obvious.

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[4] See *Sakraida* v. *Ag Pro, Inc.*, 425 U.S. 273, 280-282 (1976) (ruling that a claimed invention of a method for cleaning dairy barns was obvious); *Johnston*, 425 U.S. at 226-230 (ruling that a claimed invention of a computer program for managing bank accounts was obvious); *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57, 61-63 (1969) (ruling that a claimed invention of a paving machine was obvious); *United States* v. *Adams*, 383 U.S. 39, 48-52 (1966) (ruling that the claimed invention of a new type of battery was not obvious); *Graham*, 383 U.S. at 24-26, 32-37 (ruling, in two consolidated cases, that a claimed invention of a plow improvement and a claimed invention of a container cap were obvious).

The Federal Circuit's test departs from this Court's precedents because it treats a particular method of demonstrating obviousness—namely, proof that the prior art taught, suggested, or provided a motivation for combining the prior art references—as the *exclusive* means of showing obviousness. As the court of appeals stated in this case,

> When obviousness is based on teaching of multiple prior art references, the movant *must* also establish some "suggestion, teaching, or motivation" that would have led a person of ordinary skill to combine the relevant prior art teachings *in the manner claimed.*

Pet. App. 6a (citations omitted; emphasis added). See *id.* at 7a, 11a-12a. While this Court's flexible approach allows ample room to rely on such teachings, suggestions, or motivations as a sufficient basis for a finding of obviousness, see *United States* v. *Adams*, 383 U.S. 39, 47 (1966), the Federal Circuit's test mandates that showing as a prerequisite to an obviousness determination in any case involving a novel combination of previously known elements. See Pet. App. at 12a ("the district court was *required* to make *specific findings* as to whether there was a suggestion or motivation to combine the teachings of Asano with an electronic control *in the particular manner claimed* by claim 4" (emphasis added)).[5]

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[5] After the Court called for the views of the United States, the Federal Circuit stated that its teaching-suggestion-motivation test "is consistent with governing obviousness law," citing Section 103(a) and this Court's decisions in *Johnston* and *Graham*. See *In re Kahn*, 441 F.3d 977, 987 (2006). But the *Kahn* decision does not acknowledge the key difference: This Court's decisions nowhere suggest that a court *must* make the *specific findings* that the Federal Circuit requires. To the contrary, this Court has found that a claimed invention would have been obvious based on the small difference between the prior art and what the inventor claimed, without any mention of teaching, suggestion, or motivation. See *Johnston*, 425 U.S. at 230.

The Federal Circuit's test creates a substantial obstacle to showing that a claimed invention that simply combines known features without substantial innovation would have been obvious, because the test requires the party challenging the patent to come forward with affirmative evidence in the prior art of a teaching, suggestion, or motivation to combine the features. See, *e.g.*, *In re Kotzab*, 217 F.3d 1365, 1370-1371 (Fed. Cir. 2000); *Winner Int'l Royalty Corp.* v. *Wang*, 202 F.3d 1340, 1348-1349 (Fed. Cir. 2000); *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). That showing may be difficult or impossible even though the combination, on its face, would have been obvious. For example, such affirmative evidence may be lacking if the claim arose in a newly emerging technical field or if the combination was so obvious to persons skilled in the art that no one would have had need or incentive to record the trivial extension of the art. See John R. Thomas, *Formalism at the Federal Circuit*, 52 Am. U. L. Rev. 771, 801-802 (2003).[6]

The Federal Circuit states that the teaching, suggestion or motivation

> may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclo-

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[6] Indeed, the Federal Circuit's approach has led it to hold that "'[c]ommon knowledge and common sense,' even if assumed to derive from the [PTO's] expertise, do not substitute" for evidence of a "specific hint or suggestion" to combine prior art. See *In re Lee*, 277 F.3d 1338, 1344-1345 (2002). Thus, even when prior art is closely analogous to the invention at issue, the court has required evidence showing a particular suggestion or motivation to combine the prior art to create the invention. See *In re Dembiczak*, 175 F.3d 994, 997, 1000 (Fed. Cir. 1999) (lawn trash bag having a Halloween pumpkin design is not prima facie obvious in the absence of evidence of suggestion to combine normal trash bag with references describing pumpkin designs on paper bags).

> sures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, "leading inventors to look to references relating to possible solutions to that problem."

Pet. App. 6a (citations omitted). The court's seemingly helpful observation that the teaching, suggestion, or motivation may be found "explicitly or implicitly" has not, in practice, substantially reduced the burden that its test imposes. This case is illustrative. The district court found that the Asano patent revealed all of the elements of Claim 4 of the Engelgau patent except the mounting of a pivot-actuated electronic sensor on the adjustable pedal assembly support structure, and that other manufacturers had mounted such sensors on non-adjustable pedal assembly support structures. See *id.* at 42a-44a. The court of appeals nevertheless concluded that a mechanical engineer with experience in pedal assembly faced with the problem of mounting an electronic sensor on an adjustable pedal assembly would not be implicitly motivated to transfer the known technique for mounting the electronic sensor on the support structure of non-adjustable assemblies to adjustable assemblies. See *id.* at 11a-13a; see also 13a-15a (rejecting the district court's alternative bases for finding a teaching, suggestion, or motivation to combine the elements).[7]

The Federal Circuit justifies its rigid teaching-suggestion-motivation test as a necessary measure to eliminate the possibility of "hindsight-based obviousness analysis." Pet. App. 6a-7a (quoting *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)); see *Ruiz* v. *A.B. Chance Co.*, 234 F.3d 654, 665 (Fed.

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[7] See generally *In re Lee*, 277 F.3d at 1343 (requiring "objective evidence" of a particular "teaching, motivation, or suggestion to select and combine the [prior art] references"); *In re Dembiczak*, 175 F.3d at 999 (requiring "actual evidence" revealing a "clear and particular" reason to select and combine the elements as combined in the invention).

Cir. 2000). While an inquiry into teaching, suggestion, or motivation may shed light on the question of obviousness, this Court did not perceive a need in *Graham* or subsequent cases to employ such a rigid prophylactic test to prevent courts or patent examiners from "read[ing] into the prior art the teachings of the invention in issue." *Graham*, 383 U.S. at 36. The Federal Circuit's test effectively constricts this Court's guidance in *Graham* respecting the nonobviousness inquiry, it fails to account adequately for the problem-solving abilities of persons of ordinary skill in the art, and it underestimates the capabilities of courts and patent examiners to "resist the temptation" of hindsight and to consider fairly the question of obviousness. See *ibid.* Moreover, if there is a need for the Federal Circuit's strict measures to guard against the possibility of hindsight, this Court should make that decision itself.

B. The Question Presented Has Significant Practical Consequences And This Case Provides An Appropriate Vehicle For Its Resolution

1. The Federal Circuit's adoption and strict application of its teaching-suggestion-motivation test presents an issue of substantial and ongoing practical importance. As this case illustrates, the test renders patent examination and litigation more costly, it grants patent applicants unjustified rewards for disclosing non-innovative subject matter, and it forecloses competitors from using the public storehouse of knowledge that should be freely available to all.

The interlocutory posture of this case does not counsel against review, because further proceedings on remand are themselves a product of the Federal Circuit's rigid rule. The Federal Circuit's decision to vacate the district court's grant of summary judgment will require additional proceedings to determine whether Claim 4 of the Engelgau patent would have been obvious. The district court will be required to hold

a trial to determine, among other things, "whether a person of ordinary skill in the art would have been motivated, at the time the invention was made, to attach an electronic control to the support structure of the pedal assembly disclosed by the Asano patent." Pet. App. 16a-17a. Those costly proceedings are unnecessary. The district court convincingly explained that the combination of known elements would have been obvious to a mechanical engineer confronted with the task of developing an electronically controlled adjustable pedal. *Id.* at 40a-46a. The claimed invention here is at least as obvious as the inventions in *Graham*, see 383 U.S. at 24-26, 32-37, and *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57, 60-63 (1969). The Federal Circuit's test nevertheless prevents summary resolution of the issue, potentially grants respondents an undeserved windfall, and prevents a competitor from employing what should be "tools of creation available to all." *Bonito Boats*, 489 U.S. at 156.

The Federal Circuit's test not only shunts cases to trial that should be resolved at summary judgment, but it also unduly restricts the ability of PTO to reject obvious patent applications. Congress vested PTO with "primary responsibility for sifting out unpatentable material." *Graham*, 383 U.S. at 18. That responsibility, which requires technical expertise drawn from a wide variety of disciplines, places extraordinary burdens on patent examiners, particularly in light of the high volume of patent applications. In fiscal year 2005 alone, PTO received more than 400,000 patent applications. Section 103(a) plays a crucial role in filtering out non-innovative applications and focusing the examination efforts on substantial claims. When PTO applies its technical expertise and reasonably articulates why a patent claim is obvious under Section 103(a), that determination is entitled to deference reflecting "the primacy of the PTO in ensuring that the claims allowed cover only subject matter that is properly patentable."

Warner-Jenkinson Co. v. *Hilton Davis Chem. Co.*, 520 U.S. 17, 33-34 (1997). PTO's obviousness inquiry should not require an unnecessary search for evidence showing a particular suggestion, teaching, or motivation to make insubstantially innovative combinations of elements that are known in the prior art. PTO should instead be allowed to bring to bear its full expertise—including its reckoning of the basic knowledge and common sense possessed by persons in particular fields of endeavor—when making the predictive judgment whether an invention would have been obvious to a person of ordinary skill in the art.[8]

2. Respondents contend (Br. in Opp. 2, 17-19) that this case merely involves a routine application of summary judgment standards that does not warrant this Court's review. To the contrary, the case presents an important and recurring issue of basic importance in the field of patent law. The Federal Circuit's longstanding teaching-suggestion-motivation test has a substantial impact on commercial enterprise and innovation. See Cisco Systems Amicus Br. It also has been the subject of critical scholarly commentary. See Intellectual Property Law Professors Amicus Br. The Federal Trade Commission's comprehensive report on the United States patent system noted the controversy surrounding the teaching-suggestion-motivation test, describing it as "a core issue in assessing obviousness and a focal point of current

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[8] Cf. *City of Erie* v. *Pap's A.M.*, 529 U.S. 277, 298 (2000) (opinion of O'Connor, J.) (agency may take official notice of facts within its special knowledge and is not confined to the evidence in the record in reaching its expert judgment if party has opportunity to respond); *FCC* v. *National Citizens Comm. for Broad.*, 436 U.S. 775, 813-814 (1978) (agency's predictive judgment forecasting "the direction in which future public interest lies necessarily involves deductions based on the expert knowledge of the agency" (quoting *Federal Power Comm'n* v. *Transcontinental Gas Pipe Line Corp.*, 365 U.S. 1, 29 (1961))).

debate." See Federal Trade Comm'n, *To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy*, ch. 4, at 9-15 (2003), *available at* <www.ftc.gov/os/2003/10/innovationrpt.pdf>.

This case presents a sound vehicle for examining the merits of the Federal Circuit's test. The court of appeals squarely ruled that KSR's undisputed evidence at the summary judgment stage of the proceedings did not establish a prima facie case of obviousness under its established precedents requiring proof of a teaching, suggestion, or motivation to combine. Pet. App. 14a-15a. Respondents contested KSR's assertion that the claimed invention would be obvious to one of ordinary skill in the art, but they did not dispute the core factual record relevant to this Court's review of the court of appeals' test. See C.A. App. 1547 (Radcliffe Decl. paras. 14-16), 1550 (Andresen Decl. paras. 5-7). KSR has properly preserved its challenge to the court of appeals' teaching-suggestion-motivation test by urging in the proceedings below that this Court's decisions provided an alternative basis for affirmance. See Pet. C.A. Br. 47-50. This case accordingly presents no procedural impediments to this Court's review.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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